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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,077	09/27/2004	Christopher Norbert Johnson	P33020	1351

20462 7590 11/28/2006

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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,077

Applicant(s)

JOHNSON ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9 and 14-21 is/are rejected.
- 7) ☒ Claim(s) 10-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/27/04 & 9/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

In view of applicants' response filed 9/18/06 the following still applies.

Receipt of new Declaration listing all 4 FP documents for 119 benefit is acknowledged.

The disclosure remains objected to for reasons set forth in the previous action. Applicants may have overlooked this objection.

Claims 6-9 and 14-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Scope of solvates still remaining in the generic claims remains nonenabled. The article provided by applicants to address this rejection doesn't answer the question of which solvents can form solvates with **instant** compounds. While the article deals with solvate formation, it does not evidence that it is routine or predictable which solvent can form a solvate with a given compound. The opposite is shown. Note on p.234 the passage: "As a result, solvate formation within a series of related compounds tends to lack a discernible pattern-each compound has a

unique response to solvate formation.” Thus a reading of this article demonstrates that solvate formation is not a predictable outcome and not necessarily routine to accomplish. Applicants in the specification mention that hydrates can be formed. Insertion of such in place of “solvates” would not be objected to.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 6,7,14,15,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernotas for reasons of record. Applicants do not traverse this rejection but rather urge it is not a competent reference in view of entitlement to 119 benefit of at least 1 of 4 priority applications. While the subject matter in **each** of these claims is described totally in 1 of 4 said applications, note that entitlement to 119 benefit requires compliance with 35 USC 112, description **and** enablement. See *In re Gostelli* 10 USPQ 2nd 1614; *Kawai v. Metlesics* 178 USPQ 158 for requirements for compliance with 35 USC 112, par.one for entitlement to foreign priority. The claims rejected are not enabled for reasons given in the above 112 rejection under par.one.

Claims 8,16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson for reasons of record. Johansson describes quinoline species with piperazino at 4-position and sulfonyl moiety at 7-position as pointed out in the previous action. Johansson remains a competent reference as the claims herein are not entitled to 119 benefit for the same reason discussed immediately above.

Claims 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Said claims are free of 112 rejection maintained above and **each** of these claims is fully described in 1 of 4 foreign priority applications.

Applicants' IDS filed 9/18/06 has been considered except for GB'549 which was not provided and thus only US equivalent was thus considered.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Emily Bernhardt
Primary Examiner
Art Unit 1624